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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,142

05/17/2005

Go Mizutani

441P094

5678

42754

7590

10/24/2006

NIELDS & LEMACK

176 EAST MAIN STREET, SUITE 7
WESTBORO, MA 01581

EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/535,142

Applicant(s)

MIZUTANI ET AL.

Examiner

Michael Bernshteyn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/18/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 14, 2006 has been entered.
2. This Office Action is being provided in reply to the amendment accompanying the foregoing RCE. Applicants have amended claim 1, no claims have been cancelled or added.
3. Claims 1-3, 6-7 and 9 are active.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 6-7 and 9 are rejected under 35 U.S.C. 102(a) as being unpatentable over Ishii et al. (JP 08-194968) in view of Tokuda et al. (JP 2002-092961).

With regard to the limitations of claims 1-3, 7 and 9, Ishii discloses the protective coating agent for an optical disc, which is produced by coating the memory part of the optical disc with a radiation curing resin composition. The composition of the protective coating agent for the optical disc contains more than one (meth) acrylate, i.e., monofunctional monomer or oligomer, in a molecule (abstract).

The curing resin composition contains the following components:

- the **epoxy (meth)acrylate**, for example bisphenol A epoxy (meth)acrylate. The amount of the epoxy (meth)acrylate is desirable 5-70% by weight (page 3, [0016]);

- mono and polyfunctional acrylate monomers, such as tricyclodecane (meth)acrylate, dicyclopentadieneneoxyethyl (meth) acrylate, dicyclopentanyl (meth) acrylate, **dicyclopentanyl di (meth) acrylate**, **hydroxypivalic acid neopentyl glycol di (meth) acrylate**, etc.; monofunctional (meth) acrylate containing a hydroxyl group, such as **2-hydroxyethyl (meth) acrylate**, etc. The amount of mono and polyfunctional acrylate monomers is desirable 5-90% by weight and especially desirable 10-70% by weight. Two or more (meth) acrylates can be mixed together depending on the class of radiation used (page 2, [0012]-[0014]);
- a photopolymerization initiators, such as **2,2-dimethoxy-1,2-diphenylethan-1-one**, 1-hydroxycyclohexyl phenyl ketone, 2-hydroxy-2methyl-1-phenylpropane-1-one, etc. The photopolymerization initiator may be used alone or in a mixture of two or more. The amount of the initiators is desirable 0.5-20% by weight (page 3, [0019]-[0020]).

Ishii clearly discloses the resin compositions in the examples 1-3 which do not contain urethane (meth) acrylate (page 4, [0025]-[0027], table 1).

Ishii does not disclose that a total reflection film or a translucent reflection film comprising silver or a silver alloy.

With regard to the limitations of claims 1, 7 and 9, Tokuda discloses that UV-curable resin composition used like adhesive, which can impart high durability and hardened material thereof in a sticking type optical disk having a semitransparent

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reflecting film in which the semitransparent reflecting film of one disk substrate comprises a **silver compound** or an **alloy** thereof when two sheets of the disk substrates are stuck together by the adhesive for optical disk (abstract).

Both references are analogous art because they are from the same field of endeavor concerning new adhesive compositions for optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a silver compound or an alloy thereof when two sheets of the disk substrates are stuck together by the adhesive for optical disk as taught by Tokuda in Ishii's adhesive composition in order to obtain an adhesive, which can impart durability and hardened material thereof in a sticking type optical disk having a semitransparent reflecting film (JP'961, abstract), and thus to arrive at the subject matter of instant claim 1 and dependable claims 7 and 9.

With regard to the limitations of claim 6, Tokuda discloses that UV-curable resin composition has an electrical resistivity in the range 380-520 mPa.S/25⁰C, which is within the claimed range (Example 1-6, page 5, [0022]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Patent Examiner
Art Unit 1713

MB
10/20/2006


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